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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,029	06/22/2006	Hideaki Hirai	R2184.0524/P524	6898
24998 7590 12/27/2010 DICKSTEIN SHAPIRO LLP 1825 EYE STREET NW Washington, DC 20006-5403				
EXAMINER				
CHU, KIM KWOK				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

## Application No.

10/584,029

## Applicant(s)

HIRAI, HIDEAKI

## Examiner

Kim-Kwok CHU

## Art Unit

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**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Amendment filed on September 7, 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 5-10, 13 and 38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-10, 13 and 38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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**Claim Rejections - 35 USC § 112**

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

2. Claims 5-10, 13 and 38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding Claim 5, line 7, the phrase "for a beam focused by an objective lens" is indefinite. There are two light beams  $\lambda_1$  and  $\lambda_2$  and it is not clear whether or not the claimed focused beam is the light beams  $\lambda_1$  and  $\lambda_2$ . Furthermore, it is not clear whether the claimed "an objective lens" is a component of the claimed optical pick-up or the aberration generation device. In other words, the claimed "objective lens" and its features (last two paragraphs) should be grouped together and expressed as a component in the pickup in a similar way such as the claimed aberration generation device, the claimed first device and the claimed second device.

In addition, in Claim 5, line 9, it is not clear whether the claimed "a determination device" is a component of the optical pick-up or the claimed device.

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Similarly, in Claim 13, line 7, the phrase "for a beam focused by an objective lens" is indefinite. There are two light beams  $\lambda_1$  and  $\lambda_2$  and it is not clear whether or not the claimed focused beam is the light beams  $\lambda_1$  and  $\lambda_2$ . Furthermore, it is not clear whether the claimed "an objective lens" is a component of the Claimed optical pick-up or the aberration generation device. In other words, the claimed "objective lens" and its features (last two paragraphs) should be grouped together and expressed as a component in the pickup in a similar way such as the claimed aberration generation device.

In addition, in Claim 4, line 9, it is not clear whether the claimed "a determination device" is a component of the optical pick-up or the claimed device.

The claims not specifically mentioned above are rejected because these claims are dependent on the rejected base claims.

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***Allowable Subject Matter***

3. Claims 5-10, 13 and 38 would be allowable if rewritten to overcome the rejection under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

4. The following is an Examiner's statement of reasons for the indication of allowable subject matter:

Regarding Claim 5, the prior art of record fails to teach or fairly suggest an optical pickup having following features:

The objective lens is a lens providing a best aberration for the first optical recording medium and is provided with an aberration compensation element comprising a diffraction element or a phase shifter element between the objective lens and the aberration generation device, and

the aberration compensation element is provided with a diffraction element whereby recording or reproducing is made using light beams with selectively different diffraction orders dependent on an optical recording medium.

Regarding Claim 13, the prior art of record fails to teach or fairly suggest an optical pickup having following features:

The objective lens is a lens providing a best aberration for the first optical recording medium and is provided with an

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aberration compensation element comprising a diffraction element or a phase shifter element between the objective lens and the aberration generation device, and

the diffraction element is molded with the objective lens as one unit and a diffraction grating is formed on a surface of the objective lens at a side of a light source.

The features indicated above, in combination with the other elements of the claims, are not anticipated by, nor made obvious over, the prior art of record.

***Response to Remarks***

5. Applicant's Remarks filed on September 7, 2010 have been fully considered. The amended Claims 5-10 and 13 again rejected under the second paragraph of 35 U.S.C. 112 which is inadvertently missed in the last Office Action dated June 7, 2010.

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6. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Kim CHU whose telephone number is (571) 272-7585 between 9:30 am to 6:00 pm, Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrea Wellington, can be reached on (571) 272-4483.

The fax number for the organization where this application or proceeding is assigned is (571) 273-8300

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished application is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9191 (toll free).

/Kim-Kwok CHU/  
Examiner AU2627  
December 17, 2010

(571) 272-7585

/HOA T NGUYEN/

Supervisory Patent Examiner, Art Unit 2627